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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,895	08/06/2001	Bruce L. Daugherty	19634YDA	9048

7590

03/07/2003

Merck & Co., Inc.
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EXAMINER

MERTZ, PREMA MARIA

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 03/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/922,895

Applicant(s)
Daugherty et al.

Examiner
Prema Mertz

Art Unit
1646



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 8, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-49 is/are pending in the application.
- 4a) Of the above, claim(s) 43-49 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39 and 40 is/are allowed.
- 6) ☒ Claim(s) 36-38, 41, and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 6) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Applicant's election of Group I (claims 36-42) in Paper No. 6 (1/8/03) is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP... § 818.03(a)).

Claims 43-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed i.e. a more specific title that would identify the nucleic acid by the protein it encodes. It is suggested that the titled be amended to read approximately as follows: "nucleic acid encoding eosinophil eotaxin receptor".

3. The disclosure is objected to because of the following informalities:

On page 22, lines 6-8, the old address of ATCC in Rockville, MD is disclosed. The new address is ATCC, 10801 University Boulevard, Manassas, VA 20110-2209.

Appropriate correction in the specification is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 36-38, 41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

pm 2/24/03
Claims 36-38 embrace a nucleic acid as it occurs *in vivo* on a chromosome. However, since it would that applicants ^{do not} ~~do~~ not intend to claim a naturally occurring product, amending the claim to require the hand-of-man would obviate this rejection i.e. a isolated and purified nucleic acid.

Claim 41 embraces a host cell in the body of a transgenic animal, or a host cell in a gene therapy patient. Claim 41 encompasses human cells, fetuses and embryos, as well as non-human cells including animals, vertebrates, mammals, primates, chimeric animals, germ cells (including oocytes and sperm), fertilized eggs, fetal tissues and organs. However, since it would that applicants do not intend to claim such human cells, amending the claims to require non-human host cells and the hand-of-man would obviate this rejection i.e. an isolated non-human mammalian host cell.

Claim 42 is rejected as vague and indefinite insofar as it is dependant on claim 41 for its limitations.

Claim rejections-35 USC § 112, first paragraph

5. Claim 42 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The cell line recited in claim 42 is essential to the claimed invention. The cell line AML14.3D10, disclosed on page 22, lines 6-8, of the specification, must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. The

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instant specification does not disclose a repeatable process to obtain the cell line, and it is not apparent if this cell line is readily available to the public. If the deposit has been made under the terms of the Budapest Treaty, an affidavit or declaration by applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that the cell line has been deposited under the Budapest Treaty and that the cell line will be irrevocably and without restriction or condition be released to the public upon the issuance of a patent would satisfy the deposit requirement made herein. See 37 CFR 1.808. Further, the record must be clear that the deposit will be maintained in a public depository for a period of 30 years after the date of deposit or 5 years after the last request for a sample or for the enforceable life of the patent whichever is longer. See 37 CFR 1.806. If the deposit has not been made under the Budapest treaty, then an affidavit or declaration by applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature must be made, stating that the deposit has been made at an acceptable depository and that the criteria set forth in 37 CFR 1.801-1.809, have been met.

If the deposit was made after the effective filing date of the application for a patent in the United States, a verified statement is required from a person in a position to corroborate that the cell line described in the specification as filed are the same as that deposited in the depository. Corroboration may take the form of a showing of a chain of custody from applicant to the depository coupled with corroboration that the deposit is identical to the biological material described in the specification and in the applicant's possession at the time the application was filed.

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Conclusion

Claims 39-40 are allowable.

Claim 38-38, 41-42 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 and 35 U.S.C. 101 as set forth in this Office action.

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (703) 308-4229. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

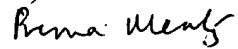
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 305-3014 or (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 746-5300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


Prema Mertz Ph.D.
Primary Examiner
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February 24, 2003